

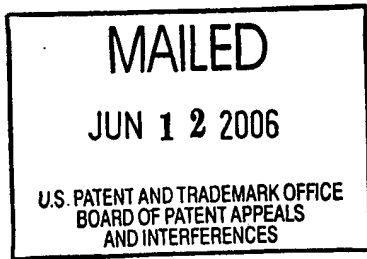
The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte MASAO TSURUTA

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Appeal No. 2006-1067  
Application No. 09/822,839

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ON BRIEF

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Before OWENS, CRAWFORD and BAHR, Administrative Patent Judges.

BAHR, Administrative Patent Judge.

**DECISION ON APPEAL**

This is a decision on appeal from the examiner's rejection of claims 1, 2 and 4.

Claim 3 stands withdrawn from consideration and claims 5-16 have been canceled.

We REVERSE.

### BACKGROUND

The appellant's invention relates to an apparatus for manufacturing a plurality of sheets by feeding the sheets and cutting off corners thereof (present specification, page

1). Claim 1 is representative of the invention and reads as follows.

1. An apparatus for manufacturing a plurality of sheets by stacking and feeding the sheets, comprising:
  - means for supplying stacked sheets;
  - means for turning the stacked sheets in a plane thereof;
  - means for vertically inverting the stacked sheets;
  - means for discharging the stacked sheets; and
  - means for transferring the stacked sheets to at least one of said turning means, said inverting means, and said discharge means.

### ***Applied Prior Art***

Fujishiro	3,595,370	Jul. 27, 1971
Monsees	5,743,374	Apr. 28, 1998
Ogura et al. (Ogura)	JP 1-210298	Aug. 23, 1989
(Japanese patent document)		

### ***The Rejections***

Claims 1 and 4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Monsees in view of Fujishiro.

Claim 2 stands rejected under 35 U.S.C. § 103 as being unpatentable over Monsees in view of Fujishiro and Ogura.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding this appeal, we make reference to the examiner's answer (mailed July 13, 2005) for the examiner's complete reasoning in support of the rejections and to the appellant's brief (filed August 25, 2004) and reply brief (filed September 13, 2005) for the appellant's arguments thereagainst.

### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art, and to the respective positions articulated by the appellant and the examiner. As explained below, we cannot sustain either of the examiner's rejections.

Monsees discloses a stack turner 10 that allows for movement both in a lateral direction as well as along an inverted u-shaped path for keeping a hopper of a carton prefeeder filled with carton blanks. The stack turner replaces a human worker who picks up stacks of blanks accumulated on an outfeed conveyor of a blank forming device, inverts them and places them in the hopper of the prefeeder. As illustrated in Figures 3A through 3H, the stack turner 10 comprises a lower portion 15 and an upper portion 50, the upper portion including a clamp 53 formed by upper plate 54, lower plate 55 and rear registration wall 66 and the lower portion including a cabinet structure 16 having means for moving the clamp 53 from a first position (Figure 3B) where it can

pick up a stack of blanks to a second position (Figure 3E) where it can drop off the stack in the hopper of a prefeeder P. The clamp is also moved along an inverted u-shaped path via rollers 56 disposed in u-shaped grooves or slots 52 in guides 51 to invert the stack as it is moved from the outfeed conveyor to the hopper of the prefeeder. As also illustrated in Figures 3A through 3H, the stack turner 10 is wheeled, via casters 17, into position between article prefeeder P and conveyor C adjacent output conveyor O of a device for forming stacks of carton blanks  $S_1$ .

Monsees lacks a means for turning the stacked sheets (blanks) in a plane thereof, as required by claim 1. The examiner relies on Fujishiro for a suggestion to provide such a feature.

Specifically, the examiner's position, as stated on pages 3 and 4 of the answer, is that such turning devices are old and well known in the art and provide various well known benefits including providing a desired orientation of stacked sheets for one or more subsequent operations, such as orientation of the workpiece for proper orientation of instructions, logos, etc. for shipping/packaging. The examiner points to Fujishiro as evidence that such turning means were known in the art at the time of appellant's invention. Fujishiro discloses a turntable 11 onto which a plurality of bundles of printed sheets are accumulated. When a predetermined number of bundles has been accumulated and a stack has been formed, the turntable is rotated 180 degrees and

the stack is transferred off the turntable onto a plurality of transferring rolls 20, 20', 20", 20'''.

The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. See In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); In re Mills, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). As stated by our reviewing court in In re Kotzab, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000):

Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant [citations omitted].

While a turntable could be added to the outfeed conveyor system of Monsees to turn the blanks in a plane thereof, there is no suggestion in the applied references to do so. In particular, there is no indication in either Monsees or Fujishiro that turning of the blanks in a plane thereof would be either necessary or desirable, for subsequent operations or any other purpose. The examiner's proposed modification of Monsees

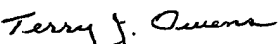
thus appears to be based on impermissible hindsight gleaned from reading appellant's specification. It follows that we cannot sustain the rejection of claim 1 or claim 4 depending therefrom.

The examiner's application of Ogura provides no cure for the deficiency in the combination of Monsees in view of Fujishiro discussed above. Accordingly, the rejection of claim 2, which depends from claim 1, as being unpatentable over Monsees in view of Fujishiro and Ogura also cannot be sustained.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2 and 4 is reversed.

REVERSED

  
TERRY J. OWENS  
Administrative Patent Judge

  
MURRIEL E. CRAWFORD  
Administrative Patent Judge

  
JENNIFER D. BAHR  
Administrative Patent Judge

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